

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 5-12 are now present in this application. Claims 5 and 9 are independent.

By this Amendment, claims 1-4 are canceled and claim 5 has been amended. No new matter is involved. Reconsideration of this application, as amended, is respectfully requested.

Priority Under 35 U.S.C. § 119

Applicants thank the Examiner for acknowledging Applicants' claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document.

Rejection Under 35 U.S.C. § 102

Claims 1-3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 6,158,257 to Ryan et al. ("Ryan"). This rejection is respectfully traversed.

This rejection is moot because claims 1-3 have been canceled.

Reconsideration and withdrawal of this rejection are respectfully requested.

Rejections under 35 U.S.C. §103

Claims 5-7 and 9-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan. This rejection is respectfully traversed.

Because the rejection is based on 35 U.S.C. §103, what is in issue in such a rejection is "the invention as a whole", not just a few features of the claimed invention. Under 35 U.S.C. §103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under Section 103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. *See In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the Examiner must explain what the differences between the claimed invention and the prior art are and provide objective factual evidence to support a conclusion that it would be obvious to one of ordinary skill in the art to achieve the claimed invention, which includes those missing features.

In the second place, in rejecting claims under 35 U.S.C. §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the

claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Eritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing

alone, are not “evidence.” *See In re Dembiczak*, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. *See In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

The Office Action admits that Ryan does not disclose the dampening device arrangement recited in claim 5, i.e., a damper comprising (1) first and second dampers provided at left and right sides under a bottom of the tub to attenuate the vertical and horizontal vibrations; and (2) a third damper provided in rear of the tub to attenuate the front-to-rear vibration.

In an attempt to remedy this deficiency, the Office Action turns to case law that does not apply to the facts at hand. The Office Action cites *In re Japikse*, 86 USPQ 70 (CCPA 1950) for the proposition that rearrangement of parts was held to have been obvious. Applicants respectfully disagree with the statement of the holding in this case and assert that it is also improperly applied to the facts at hand.

A reading of the “Japikse” case reveals that Japikse claimed a hydraulic power press. Claim 3 of Japikse allegedly read on the Cannon reference except for the feature, “means disposed in alignment with said opening for contact by said depending means to start the pressing operation of said hydraulic press.” The Board held that there would be no invention in shifting the starting switch disclosed by Cannon to a different position since the operation of the device would not thereby be modified (emphasis added). The Court found no error in that holding of the Board.

In the first place, Applicants respectfully submit that it is completely improper to base a rejection on the broad, general principle quoted above, which is incorrect in the sense that it does not address a rearrangement that affects the operation of Ryan's specific device, and is not clear and particular objective factual evidence which would motivate one of ordinary skill in the art to modify Ryan to redesign and reconstruct Ryan to provide the claimed damper structure. *See* in this regard, the aforementioned case law including, "In re Lee" and "In re Dembiczkak." Moreover, this approach does not address the invention as a whole, as required by the decision in the previously cited "Graham v. John Deere" case. Evidence of this is in the language found in this case, which is eschewed by subsequent case law, i.e., "there is no invention in." That is not the standard for evaluating obviousness of an invention under the subsequently enacted 1952 Patent Act.

Relying on such a statement is inconsistent with the principles set down by "Graham v. John Deere," and "In re Lee" and "In re Dembiczkak," and makes this rejection fundamentally improper.

Moreover, the reliance on the stated holding in this pre-1952 Patent Act case provides no objective evidence of the desire of one of ordinary skill in the art to redesign the fundamental structure of Ryan in such a counter-intuitive manner, i.e., replacing two fixed, non-hinged, dampers, one located in front of the tub, the other being located behind the tub, connected to the top of the cabinet, with the claimed three element damper structure, two of which are provided at right and left sides under a bottom of the tub and a third located in the rear of the tub.

Additionally, the Office Action fails to explain how this fundamental redesign of Ryan which deals with the operational aspects of Ryan's device, relates to locating a power switch for a hydraulic press that had no effect on the operation of the hydraulic device in issue in "Japikse."

Because Ryan fails to disclose the recited damper structure feature which affects the operation of the claimed invention, and no objective evidence is shown of such a feature existing in the art, this rejection must be based on improper speculation and/or impermissible hindsight.

Furthermore, the Office Action relies upon the assertion that rearrangement of parts was held to have been obvious as establishing a *per se* rule that any modification of a reference is obvious simply by citing the "In re Japikse" decision and stating that that case held rearrangement of parts was obvious. As noted above, no direction is given to a skilled worker of why the claimed damper structure should be preferred. Moreover, as stated by the Federal Circuit in In re Ochiai, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995), "reliance on *per se* rules of obviousness is legally incorrect and must cease."

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the claimed invention.

Reconsideration and withdrawal of this rejection of claims 5-7 and 9-11 are respectfully requested.

Claims 4, 8 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of U.S. Patent 5,907,880 to Durazzani et al. (“Durazzani”). This rejection is respectfully traversed.

Applicants respectfully submit that this rejection is moot with respect to claim 4, which has been canceled.

Claims 8 and 12 depend from claim 5, and the Office Action fails to make out a *prima facie* case of obviousness of claim 5 based on Ryan for reasons stated above. Moreover, Durazzani is not applied to remedy the aforementioned deficiencies of Ryan. So, even if one of ordinary skill in the art were properly motivated to modify Ryan in view of Durazzani, as suggested (which is not the case for reasons discussed, below), the resulting modified version of Ryan would neither moot, nor render obvious the claimed invention.

The Office Action also fails to provide objective factual evidence that one of ordinary skill in the art would turn to Durazzani to modify Ryan, as suggested. Ryan clearly discloses that its non-hinged suspension subassemblies 18 and 20 are “softer” (more compliant) than conventional tub suspension subassemblies. This is reason enough not to turn to Durazzani to modify the more compliant subassemblies of Ryan which, as clearly shown in Fig. 1 of Ryan, do not include hinges, or show a rigid coupling scheme, or connect pistons 48 to the drum. In fact, this improved, softer, more compliant structure taught by Ryan is reason for one of ordinary skill in the art not to turn to Durazzani to modify Ryan to arrive at the claimed invention.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the claimed invention recited in claims 8 and 12.

Reconsideration and withdrawal of this rejection of claims 4, 8 and 12 are respectfully requested.

Additional Cited References

Because the remaining reference cited by the Examiner has not been utilized to reject the claims, but has merely been cited to show the state of the art, no comment need be made with respect thereto.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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